

REMARKS

Status of the Claims

Upon entry of the present amendment, claims 24-88 and 102-116 and 124-131 will be pending. Claims 117-123 have been cancelled without prejudice or disclaimer. Applicants reserve the right to pursue the subject matter of the cancelled claims in one or more continuing or divisional applications.

Punctuation errors have been corrected in claims 46 and 61.

Claims 76, 102 and 124 has been amended to recite that the claimed polypeptide "binds Fas ligand." Support for these amendments may be found, for example at page 160, lines 14-16, page 197, lines 6-12 and Example 7. Thus, no new matter has been introduced by way of amendment.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 117-131 under 35 U.S.C. §112, first paragraph for allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants respectfully disagree.

Preliminarily, Applicants note that claim 117, and claims dependent therefrom have been cancelled. Accordingly, this rejection insofar as it applies to claims 117-123 has been obviated or overcome.

Moreover, Applicants have amended claim 124 to recite that the claimed polypeptide "binds Fas ligand." Accordingly, Applicants believe the present rejection has been obviated or overcome. Applicants respectfully request that this rejection be reconsidered and withdrawn.

Entitlement to Priority

The Examiner asserts that the present application is not entitled to receive the benefits of priority under 35 U.S.C. §§ 120 or 119(e) with respect to the 09/006,352 and 60/035,496 applications because said applications allegedly do not disclose a specific and substantial utility. The Examiner has accorded the present application an effective filing date of March 4, 1999.

Applicants respectfully disagree.

As stated in M.P.E.P. §2107.02, “an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C. 101 and 35 U.S.C. 112...See, e.g., *Raytheon v. Roper*, 724 F.2d 951, 958, 220 USPQ 592, 598 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 835 (1984) (‘When a properly claimed invention meets at least one stated objective, utility under 35 U.S.C. 101 is clearly shown.’)”.

The claimed polypeptides have a specific and substantial utility, for example, in the treatment of graft vs. host disease. This utility is clearly disclosed in the present specification in the paragraph bridging pages 8 and 9, and in the earliest application to which the present application claims priority, namely Application Serial No. 60/035,496 filed January 14, 1997, in the second full paragraph on page 7.

This utility has been confirmed, for example, by Zhang et al., *Journal of Clinical Investigation* 107:1459 (2001), reference CD on the Revised form PTO/SB/08 submitted November 20, 2001, who show that TR6-Fc¹ treatment reduces symptoms in a murine model of graft vs. host disease. The Federal Circuit held in *In re Brana*, evidence dated after the filing date “can be used to substantiate any doubts as to the asserted utility since this pertains to the accuracy of a statement already in the specification.” 51 F. 3d. 1560, 1567 at n19 (Fed. Cir. 1995). Such evidence “goes to prove that the disclosure was in fact enabling when filed (*i.e.*, demonstrated utility).” *Id.*, citing *In re Marzocchi*, 439 F2d. at 224 n.4, 169 U.S.P.Q. at 370 n.4.

Applicants emphasize that the asserted utility in the present application is adequate under all applicable authority. Applicants’ asserted utility is a specific, substantial and credible utility and not a “throw away” utility (such as using a composition for landfill) as defined in the current United States Patent and Trademark Office’s Utility Guidelines.

Accordingly, Applicants maintain that the present application is entitled to receive the benefits of priority under 35 U.S.C. §§ 120 or 119(e) with respect to the 09/006,352 and 60/035,496 applications and that the present application should be accorded an effective filing date of January 14, 1997.

¹ Full-length human TR6 in Zhang et al. is the same as TNFR6-alpha (SEQ ID NO:2) of the present application.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 24-88 and 102-131 under 35 U.S.C. §102(e), as being anticipated by Ashkenazi et al., U.S. Patent No. 6,764,679 which the Examiner has assigned an effective priority date of September 19, 1998.

As described above, the present application is entitled to a priority date of January 14, 1997 and thus, the Ashkenazi reference, U.S. Patent No. 6,764,679, is not available as prior art under 35 U.S.C. §102 with respect to the present application. Accordingly, Applicants respectfully request that the present rejection be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants believe that this application is now in condition for allowance, and an early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for in the Petition for an Extension of Time submitted concurrently herewith, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Dated: October 11, 2005

Respectfully submitted,

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